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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,447	08/20/2001	William D. Hogan	2380-464	3509

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NIXON & VANDERHYE P.C.
8th Floor
1100 North Glebe Road
Arlington, VA 22201

EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT	PAPER NUMBER
2686	9

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,447

Applicant(s)

HOGAN, WILLIAM D.

Examiner

Joy K Contee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5-8.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-62 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6,14,15 and 31-35 of copending Application No. 10/068,012 ('012). Although the conflicting claims are not identical, they are not patentably distinct from each other because at least independent claims 1 and 31 of '012 disclose transmitting to the user equipment unit a message including a filtered list of cells the filtered list of cells including the first subset but not the second subset, which is analogous to the instant applications at least independent claims' 1,29 and 48, filtering rule criteria for determining whether the candidate cell qualifies for inclusion in a measurement list of cells.

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Omission of element and its function in combination is obvious expedient if remaining elements perform same functions as before. In re KARLSON (CCPA) 136 USPQ 184 (1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 21-28 and 63-69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6,14,15 and 31-35 of copending Application No. 10/068,012 ('012), in view of Cutler, Jr. et al. (Cutler), U.S. Patent No. 5,678,184.

At least independent claims 1 and 31 of '012 disclose transmitting to the user equipment unit a message including a filtered list of cells the filtered list of cells including the first subset but not the second subset, which is analogous to the instant applications at least independent claims' 1,29 and 48, filtering rule criteria for determining whether the candidate cell qualifies for inclusion in a measurement list of cells.

'012 fails to disclose using the IMSI to determine : (1) whether the measurement list for the user equipment unit should be updated to delete the candidate cell; (2) whether the radio link for the selected cell should be removed.

In a similar field of endeavor, Cutler discloses determining : (1) whether the measurement list for the user equipment unit should be updated to delete the candidate cell; (2) whether the radio link for the selected cell should be removed (col. 2, lines 34-48).

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At the time of the invention it would have been obvious to one ordinary skill in the art to modify '012 to include dynamic candidate handoff cell lists for the purpose of allowing subscriber units the handoff process based on local conditions such that poor handoff decisions are not made.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6,8,9,12-13,15-20,29,30,33,34,36,37,40-41,43-50,55,58,59, 61 and 62 are rejected under 35 U.S.C. 102(e) as being anticipated by Willars et al., U.S. Patent Application Pub. No. US 2003/0013443.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1, 29 and 48, Willars discloses for use in a telecommunications system having a serving radio network controller (SRNC) which controls a connection with a user equipment unit and a drift radio network controller (DRNC), a method comprising transmitting from the drift radio network controller (DRNC) to the serving radio network controller (SRNC) a filtering rule for a candidate cell, the filtering rule providing criteria for determining whether the candidate cell qualifies for inclusion in a measurement list of cells for the user equipment unit, **see page 3 [0029]**.

Regarding claims 2, Willars discloses the method of claim 1, further comprising performing a handover of the user equipment unit to a target cell controlled by the drift radio network controller (DRNC) whereby the user equipment unit utilizes resources including radio resources of the target cell, and wherein the candidate cell is a neighboring cell for the target cell, **see page 3 [0030]**.

Regarding claim 3, Willars discloses the method of claim 1, wherein the filtering rule is a list of subscriber groups which are allowed for the candidate cell, **see page 3 [0029]**.

Regarding claim 4, Willars discloses the method of claim 1, wherein the filtering rule is a list of subscriber groups which are not allowed for the candidate cell, **see page 3 [0029]**.

Regarding claim 5, Willars discloses the method of claim 1, wherein the filtering rule is a list of PLMN identifiers or IMSI ranges which are allowed for the candidate cell, **see page 3 [0030]**.

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Regarding claim 6, Willars discloses the method of claim 1, wherein the filtering rule is a list of PLMN identifiers or IMSI ranges which are not allowed for the candidate cell, **see page 3 [0029]**.

Regarding claim 8, Willars discloses the method of claim 1, further comprising transmitting from the drift radio network controller (DRNC) to the serving radio network controller (SRNC) filtering rules for plural candidate cells, **see page 3 [0029]**.

Regarding claim 9, Willars discloses the method of claim 8, further comprising: associating a group of plural candidate cells with a common filtering rule; transmitting the common filtering rule to the serving radio network controller (SRNC) only once rather than for each candidate cell in the group , **see page 3 [0033]**.

Regarding claim 12, Willars discloses the method of claim 1, further comprising: transmitting an international mobile subscriber identity (IMSI) of the user equipment unit from the serving radio network controller (SRNC) to the drift radio network controller (DRNC); using the filtering rule at the drift radio network controller (DRNC) to determine whether another cell qualifies for inclusion in the measurement list for the user equipment unit, the another cell being other than the candidate cell, **see page 3 [0032]**.

Regarding claim 13, Willars discloses the method of claim 12, further comprising, after using the filtering rule at the drift radio network controller (DRNC), transmitting from the drift radio network controller (DRNC) to the serving radio network controller (SRNC) a list of one or more qualifying cells for inclusion in the measurement list, **see page 3 [0033]**.

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Regarding claim 15, Willars discloses the method of claim 12, further comprising optionally using the filtering rule at the drift radio network controller (DRNC) to determine whether the another cell qualifies for inclusion in the measurement list for the user equipment unit , **see page 8 [0077]**.

Regarding claim 16, Willars discloses the method of claim 12, wherein the step of transmitting the international mobile subscriber identity (IMSI) of the user equipment unit from the serving radio network controller (SRNC) to the drift radio network controller (DRNC) occurs after transmitting the filtering rule for the candidate cell to the serving radio network controller (SRNC) , **see page 8 [000076]**.

Regarding claim 17, Willars discloses the method of claim 1, further comprising operating both the serving radio network controller (SRNC) and the drift radio network controller (DRNC) as a shared network , **see page 8 [000075]**.

Regarding claim 18, Willars discloses the method of claim 1, further comprising operating the serving radio network controller (SRNC) and the drift radio network controller (DRNC) as separate networks whereby cells controlled by the serving radio network controller (SRNC) have differing filtering rules than cells controlled by the drift radio network controller (DRNC), **see page 8 [0081]**.

Regarding claim 19, Willars discloses the method of claim 1, further comprising having differing filtering rules for cells controlled by a same radio network controller (RNC), **see page 4 [0046]**.

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Regarding claim 20, Willars discloses the method of claim 1, wherein the filtering rule is stored per cell relation, where a cell relation points to a target cell to which a source cell can handover , **see page 5 [0055]**.

Regarding claim 30, Willars discloses the apparatus of claim 29, further comprising an inter-RNC link over which the filtering rule is transmitted from the drift radio network controller (DRNC) to the serving radio network controller (SRNC), **see page 3 [0030]**.

Regarding claim 33, Willars discloses the apparatus of claim 29, wherein the filtering rule is stored at the drift radio network controller (DRNC), and wherein the filtering rule is a list of PLMN identifiers or IMSI ranges which are allowed for the candidate cell, **see page 7 [0070] & page 8 [0077]**.

Regarding claim 34, Willars discloses the apparatus of claim 29, wherein the filtering rule is stored at the drift radio network controller (DRNC), and wherein the filtering rule is a list of PLMN identifiers or IMSI ranges which are not allowed for the candidate cell, **see page 7 [0070] & page 8 [0077]**.

Regarding claim 36, Willars discloses the apparatus of claim 29, wherein the drift radio network controller (DRNC) transmits to the serving radio network controller (SRNC) filtering rules for plural candidate cells, **see page 3 [0029]**.

Regarding claim 37, Willars discloses the apparatus of claim 36, wherein a group of plural candidate cells are associated with a common filtering rule, and wherein the drift radio network controller (DRNC) transmits the common filtering rule to the

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serving radio network controller (SRNC) only once rather than for each candidate cell in the group, **see page 3 [0033]**.

Regarding claim 40, Willars discloses the apparatus of claim 29, wherein: the serving radio network controller (SRNC) transmits an international mobile subscriber identity (IMSI) of the user equipment unit to the drift radio network controller (DRNC); the drift radio network controller (DRNC) uses the filtering rule to determine whether another cell qualifies for inclusion in the measurement list for the user equipment unit, the another cell being other than the candidate cell, **see page 8 [0077]**.

Regarding claim 41, Willars discloses the apparatus of claim 40, wherein the drift radio network controller (DRNC), after using the filtering rule at the drift radio network controller (DRNC), transmits to the serving radio network controller (SRNC) a list of one or more qualifying cells for inclusion in the measurement list **see page 8 [0077]**.

Regarding claim 43, Willars discloses the apparatus of claim 40, wherein the drift radio network controller (DRNC) optionally uses the filtering rule to determine whether the another cell qualifies for inclusion in the measurement list for the user equipment unit, **see page 8 [0077]**.

Regarding claim 44, Willars discloses the apparatus of claim 29, wherein the serving radio network controller (SRNC) and the drift radio network controller (DRNC) are a shared network, **see pages 4-5 [0049]**.

Regarding claim 45, Willars discloses the apparatus of claim 29, wherein the serving radio network controller (SRNC) and the drift radio network controller (DRNC) are separate networks whereby cells controlled by the serving radio network controller

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(SRNC) have differing filtering rules than cells controlled by the drift radio network controller (DRNC) **see page 4 [0046]**.

Regarding claim 46, Willars discloses the apparatus of claim 29, wherein differing filtering rules exist for cells controlled by a same radio network controller (RNC) **see page 4 [0046]**.

Regarding claim 47, Willars discloses the apparatus of claim 29, wherein the filtering rule is stored per cell relation, where a cell relation points to a target cell to which a source cell can handover , **see page 8 [0081]** .

Regarding claim 50, Willars discloses the apparatus of claim 48, wherein the filtering rule is stored at the drift radio network controller (DRNC), and wherein the filtering rule is a list of PLMN identifiers or IMSI ranges which are not compatible with the candidate cell, **see page 8 [0077]**.

Regarding claim 54, Willars discloses the apparatus of claim 48, wherein the drift radio network controller (DRNC) transmits to the serving radio network controller (SRNC) filtering rules for plural candidate cells , **see page 8 [0077]**..

Regarding claim 55, Willars discloses the apparatus of claim 54, wherein a group of plural candidate cells are associated with a common filtering rule, and wherein the drift radio network controller (DRNC) transmits the common filtering rule to the serving radio network controller (SRNC) only once rather than for each candidate cell in the group, **see page 3 [0033]**.

Regarding claim 58, Willars disclose the apparatus of claim 48, wherein: the drift radio network controller (DRNC) receives an international mobile subscriber identity

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(IMSI) of the user equipment unit from the serving radio network controller (SRNC); the drift radio network controller (DRNC) uses the filtering rule to determine whether another cell qualifies for inclusion in the measurement list for the user equipment unit, the another cell being other than the candidate cell , **see page 8 [0076]**.

Regarding claim 59, Willars disclose the apparatus of claim 58, wherein the drift radio network controller (DRNC), after using the filtering rule at the drift radio network controller (DRNC), transmits to the serving radio network controller (SRNC) a list of one or more qualifying cells for inclusion in the measurement list , **see page 8 [0077]**.

Regarding claim 61, Willars discloses the apparatus of claim 58, wherein the drift radio network controller (DRNC) optionally uses the filtering rule to determine whether the another cell qualifies for inclusion in the measurement list for the user equipment unit , **see page 8 [0075]**..

Regarding claim 62, Willars discloses the apparatus of claim 48, wherein the filtering rule is stored per cell relation, where a cell relation points to a target cell to which a source cell can handover, **see page 8 [0081]**.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wallentin, U.S. Patent No. 6,233,222, discloses a telecommunications interexchange congestion control.

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Anell, U.S. Patent No. 5,905,950, discloses a method and apparatus for providing fixed cellular functionality.

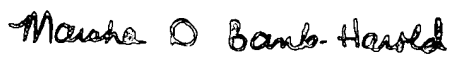
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K Contee whose telephone number is 703-308-0149. The examiner can normally be reached on M (alternating), T & Th, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703-305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Joy Contee

September 30, 2004


MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600